

REMARKS/ARGUMENTS

Claims 1-32 remain in the application. No claims are currently amended. No claims are currently cancelled.

Information Disclosure Statement:

The Examiner is thanked for acknowledging the Applicant's Information Disclosure Statement made March 3, 2003.

Claim Rejections Under 35 USC:

Claims 6, 10, 11, 16-18, 21, 24, 25 and 27-29 were rejected under 35 USC § 102(e) as being anticipated by US Patent 6,534,726 to Okada et al. Claims 1, 2, 4, 5, 7-9, 12-15, 19, 22, 23, 26, 30 and 31 were rejected under 35 USC § 103(a) as being unpatentable over Okada et al.

Okada et al. is an improper reference. As recited in the inventor's affidavit under 37 CFR § 1.131 attached hereto, the present invention was conceived and reduced to practice before the Okada et al. patent was filed in the United States. The facts upon which the inventor's affidavit relies are substantiated by:

(1) a copy of two pages of drawings identified as "FILE: PLCCADAPTER" and dated 08/14/2000, wherein the drawings show that details of the present invention were invented on or about August 14, 2000; and

(2) a copy of an Invention Record (Docket) No. H0001886 executed November 29, 2000, that is attached hereto with later-prepared drawings that facilitate an understanding of the invention, wherein the joint inventors indicate a "conception" date of September 15, 2000, (see, page 1, paragraph 4(a)), and indicate a "First practice date" of October 16, 2000 (see, page 2, paragraph 5(a)).

The inventor's affidavit testifies to the inventor's diligence in preparing and filing a United States patent application disclosing and claiming the invention. Evidence of such diligence is shown by:

(1) preparation of the Invention Record (Docket) No. H0001886 (discussed above, a copy enclosed herewith) which includes written description of the invention and 6 drawing figures that facilitate an understanding of the invention; and

(2) preparation and filing of Provisional patent application Serial No. 60/262,474, prepared and filed in the names of Richard Olzak and Tehmosp Khan on January 17, 2001, entitled: *ADAPTER FOR PLASTIC-LEADED CHIP CARRIER (PLCC) AND OTHER SURFACE MOUNT TECHNOLOGY (SMT) CHIP CARRIERS*, which discloses the claimed invention as prescribed by 35 USC § 112.

Evidence of continuous diligence is U.S. Nonprovisional patent application Serial No. 10/052,715, prepared and filed in the names of Richard Olzak and Tehmosp Khan on January 17, 2002, entitled: *ADAPTER FOR PLASTIC-LEADED CHIP CARRIER (PLCC) AND OTHER SURFACE MOUNT TECHNOLOGY (SMT) CHIP CARRIERS*, which is a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and sets forth the best mode contemplated by the inventor of carrying out his invention, as prescribed by 35 USC § 112, and includes drawings that facilitate an understanding of the invention.

Okada et al. does not claim the same patentable invention claimed in the present application such that the attached inventor's affidavit under 37 CFR § 1.131 is effective to overcome the Okada et al. reference.

The invention of Okada et al. as recited in claim 1 is a module substrate comprising a substrate for mounting an electronic component on the front surface side thereof, and end-face electrodes provided in end-faces defining an outer peripheral edge of the substrate and adapted to be connected to the electronic component, said end-face electrodes each being provided with a solder to be connected to a mother board provided on the back surface side of the substrate, said solder being protruded on the back surface side of the substrate past a thickness of a portion of the end-face electrode extending onto the back surface side of the substrate and comprising a columnar shape without a laterally projecting portion on the portion of the end-face electrodes disposed on the back surface side of the substrate.

As recited in claim 8, the invention of Okada et al. is a method of producing a module substrate comprising a substrate for mounting an electronic component on the front surface side thereof, and end-face electrodes provided in the end-faces defining the outer peripheral edge of the substrate and adapted to be connected to the electronic component, said

end-face electrodes each being provided with a solder to be connected to a mother board, the method comprising the steps of: forming the solder into a columnar shape longer than the thickness of the substrate and past a thickness of a portion of the end-face electrode extending onto a back surface side of the substrate, and providing the solder on the end-face electrode with a part of the solder having the columnar shape being protruded on the back-surface side of the substrate such that the solder does not have a portion extending laterally from the columnar shape onto the portion of the end-face electrode extending into the back-surface side of the substrate.

By contrast to the inventions claimed in Okada et al., the present invention, as recited in claim 1, is an adapter for a surface mount device, the adapter comprising: an insulating body having offset first and second surfaces; a pattern of surface mount solder pads formed on the first surface; a pattern of signal carriers communicating between the first and second surfaces, each of the signal carriers being at least partially exposed in an area between the first and second surfaces and adjacent to the second surface; and a plurality of signal lines electrically coupling one or more of the surface mount solder pads with predetermined ones of the signal carriers.

Though different in scope, other claims of the present invention are, the above description of claim 1 is sufficiently applicable to the remaining claims as to make repetition unnecessary. Thus, the remaining claims are also believed to be different from the invention claimed in the Okada et al. reference.

Therefore, the Applicants respectfully request disqualification of US Patent 6,534,726 to Okada et al. as a reference and reconsideration and withdrawal of the rejections.

Allowable Subject Matter:

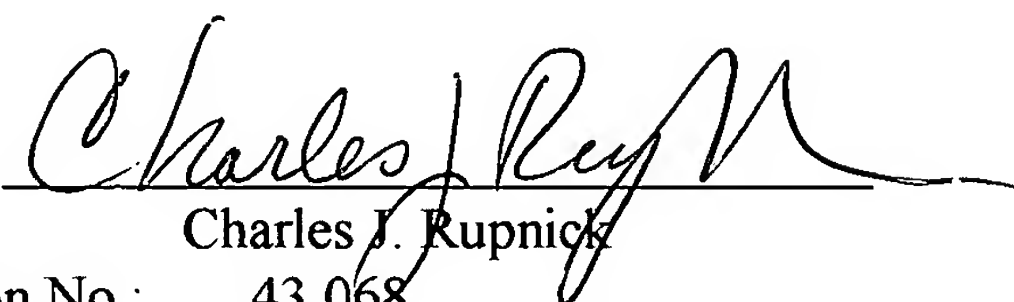
The Examiner is thanked for acknowledging that claims 3 and 32 contain allowable subject matter and noticing that both would be allowable if rewritten in independent form. However, the Applicants believe that base claims 1 and 27 from which claims 3 and 32 respectively depend are allowable and that claims 3 and 32 are allowable as depending from respective allowable base claims 1 and 27. The Applicants therefore decline to rewrite claims 3 and 32 in independent form at this time, but reserve the right to so rewrite the claims in the future.

The claims being in condition for allowance, issue of a Notice of Allowance is respectfully requested.

Serial No. 10/052,715  
Amdt. dated October 31, 2003  
Reply to Office action of July 3, 2003

If the Examiner has questions or wishes to discuss any aspect of the case, the Examiner is encouraged to contact the undersigned at the telephone number given below.

Respectfully submitted,

Attorney:   
Charles J. Rupnick

Registration No.: 43,068  
Date: October 31, 2003  
Post Office Address: PO Box 46752  
Seattle, WA 98146  
Telephone: (206) 439-7956  
Facsimile: (206) 439-3223